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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,608	06/21/2000	Valeria Palestini	3572-18	7300

7590 07/17/2002

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EXAMINER

HESS, DANIEL A

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/598,608

Applicant(s)

PALESTINI ET AL.

Examiner

Daniel A Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 26-33 is/are rejected.
- 7) ☒ Claim(s) 19-25 and 34-36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 18, 26-28, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (US 5,825,011).

Suzuki shows an optical reader having all of the elements and means as discussed in claims 1-7, 26-28, 32 and 33 drawn to the apparatus and claim 18, drawn to the method. *In discussing these claims the examiner wishes to point out that the applicant clearly states (page 1, lines 20-22) that the phrase 'indication of the reading result' means either (i) mere indication of the end of the reading or (ii) of an unsuccessful attempt. For the sake of examination, the examiner will use the first definition, as it is more broad.*

Suzuki teaches the following:

Re claims 1, 26, 27, 32 and 33: There is (column 2, lines 35-65) a code reader having illumination and reading capability. A secondary light source 17 is present (column 5, lines 23-25) which directs light at the optical code. The light provides spot lighting for indicating the center of the read area (column 5, line 30). As figure 6 shows, the sub-lights are turned off in STP12 prior to reading, and then are turned on, still directed at the code upon completion of the reading (STP16), conditionally on whether a 'YES' occurred in STP14. This means that positive visual indication of the end of reading occurs in the form of light directed at the optical code.

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Re claim 2: A decoder is present inside the reader. In figure 6, STP17-STP19 illustrate the decoding process. Whether decoding occurs inside or outside of the reader is a design choice.

Re claim 3: A switch is implied if the light go to turn on and off.

Re claim 4: The selection process is indicated by the loop in figure 6. If the answer to the conditional is 'NO' there will be no advancing to STP16.

Re claims 5, 6 and 28: Diffractive elements, diaphragms with a predetermined shape, slides, reflecting surfaces with a predetermined shape/shutter, and diffractive elements and holograms are all alternative and equivalent ways of controlling the light source. However they are equivalent to a switch when the purpose is merely to indicate the completion of a read operation.

Re claim 7: A light source must by necessity be present to project light onto the barcode.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 8, 12-14 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki.

Re claim 8: It would have been obvious to one of ordinary skill in the art at the time the invention was made use the barcode acquisition light source as the indictating light source because it is already present and to use it saves the expense of including another light source.

Re claims 12, 13, 14 and 30: Although a converging lens is not explicitly shown in Suzuki, the examiner takes Official Notice that the use of lenses and other means in optical code scanners is notoriously old and well known in the art. Their inclusion at the time of the invention would have been obvious to improving scanning resolution and sensitivity.

5. Claims 9, 15-17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in further view of Bard et al. (US 5,856,660).

Re claims 9 and 29: Bard (column 3, lines 42-44) discusses the use in prior art of a green light to indicate a successful scan.

In view of Bard's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known colored light indication of Bard into Suzuki because users are familiar (from driving, etc.) with the concept of moving on

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in response to certain colors (green) and stopping to check conditions in response to other colors (red).

Re claims 15-17 and 31: As Bard notes (column 3, lines 42 – 43) it is common in the art to use a light flashed at the operator to indicate a successful read, or alternatively or in combination, there may be a beep.

In view of the prior art mentioned by Bard, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known light and/beep directed at the operator of a barcode scanner into the inventive apparatus of Bard because these means ensure that an immediate result of the scan will be conveyed to the user through the sense of sight in the form of a flash of light, and in through the sense of sound in the form of a beep. These signals are hard to miss.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in further view of Foster (US 5,587,704).

Re claim 10: Suzuki fails to show a flashing light mechanism, in other words, a mechanism that modulates the intensity of a light or turns it on or off.

Foster shows a flashing light which works to grab the attention of individuals who see it, in a manner that is very hard to miss (see abstract).

In view of Foster, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known flashing light and light of modulating intensity shown by Foster in the teachings of Suzuki because as Foster illustrates,

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this is a great attention-grabber. It would thus have been a good way to provide important information to the operator of a barcode scanner.

***Allowable Subject Matter***

7. Claims 19-25, 34, 35 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Suzuki does not discriminate between successful and unsuccessful reads, only reads that have completed and reads that have not completed. Claim 19 refers to discriminating between at least two possible outcomes. Claims 20-23, 34, 35 and 36 refer to a negative result, but again, Suzuki does not have a negative result, only an absence of reading completion. For that matter, there isn't an indication of whether the code that has been read is a valid code that corresponds with a particular product in the store. Re claims 24 and 25, Suzuki gives no motivation for a second luminous information.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.
11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



\*\*\* DH  
July 12, 2002

Daniel A Hess  
Examiner  
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KARL D. FRECH  
PRIMARY EXAMINER